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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,534	03/11/2005	Naoyuki Suzuki	05113/HG	9534
1933 7590 08/19/2008 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708				
EXAMINER				
CHANG, VICTOR S				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
08/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,534

Applicant(s)

SUZUKI ET AL.

Examiner

VICTOR S. CHANG

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-29 is/are pending in the application.
- 4a) Of the above claim(s) 8, 10, 12, 13, 15, 17-19, 27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 11, 14, 16, 20-26 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/14/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. Applicants' amendments and remarks filed on 5/14/2008 have been entered. Claims 8, 9 and 25 have been amended. New claims 28 and 29 have been entered. Since claim 28 depends upon withdrawn claim 27, it is withdrawn as well. Claims 9, 11, 14, 16, 20-26 and 29 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Rejections Based on Prior Art

4. Claims 9, 11, 14, 16, 20-24, 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wisotzky et al. [US 3728182] in view of Wisotzky et al. [US 3560284] and JP 49-052860.

The invention of Wisotzky '182 relates to a carpet tile segment suitable for installation on surfaces without adhesive (loose-lay floor tile). Embossing or other operations is used to provide a skid-resistant backing [col. 5, ll. 47-58]. Figs 1 and 2 illustrate that the backing is produced by fusing (solidifying) a layer of liquid vinyl plastisol, which is disposed on the back face of the carpet tile. The backing composition comprises vinyl chloride copolymer and plasticizer [col. 5, ll. 10-75]. The backing may be mechanically foamed [col. 6, ll. 35].

For claims 9, 11, 14, 16, 20, 22 and 29, Wisotzky '182 is silent about the composition of the comonomer of the vinyl chloride copolymer and a silicone surfactant (hydrophobic foam stabilizer). However, the invention of Wisotzky '284 relates to a carpet having a non-skid backing of fused plastisol [col. 3, ll. 34-47; col. 5, ll. 75]. The plastisol comprises a vinyl chloride based polymer, preferably a vinyl chloride/vinyl acetate copolymer, wherein the vinyl acetate component of the copolymer is in the range of 5 to 15% by weight. Conventional plasticizers such as dioetyl phthalate (phthalic acid based plasticizer) are employed. Plasticizers are employed at a level of 60 to 120 parts of plasticizer per 100 parts of resin on a weight basis [col. 3, ll. 66 through col. 4, ll. 2]. It would have been obvious to one of ordinary skill in the art to select the vinyl plastisol of Wisotzky '284 to form the mechanically foamed backing of Wisotzky '182, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Regarding the silicone surfactant, JP '860 relates to a fused foam formed from a mechanically foamed PVC based plastisol, and teaches that the plastisol mixture comprises a silicone surfactant. It would have been obvious to one of ordinary skill in the art to modify the plastisol mixture of Wisotzky with a silicone surfactant taught by JP '860, motivated by the desire to obtain the beneficial effect of the silicone surfactant.

For claims 21, 23, the Official notice that di-2-ethylhexyl phthalate and diisononyl phthalate are known functionally equivalent phthalic acid based plasticizers for forming plastisols of vinyl chloride based polymers has been taken as admitted prior art.

For claims 24 and 25, since the collective teachings of prior art render the general structure and composition obvious, and for the same end use as the claimed invention, a

workable foam expansion ratio is deemed to be an obvious optimization to one of ordinary skill in the art, dictated by the same required foam properties for the same use.

For claim 26, Wisotzky '182 teaches that the foam material is embossed to form a skid-resistant backing, and Wisosuch '284 exemplifies the non-resistant pattern as a waffle-like pattern [col. 2, ll. 46], which comprises crossed stripes.

Response to Arguments

5. Applicants argue at Remarks page 11 that

“Wisotzky et al. fail to teach or suggest that the plastisol contains a foam stabilizer and is mechanically foamed.”

However, Wisotzky '182 teaches that the backing may be mechanically foamed, as set forth above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Examiner, Art Unit 1794